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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,598	11/21/2001	Johannes I.M. Cobben	00771.00023	6958

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BANNER & WITCOFF  
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WASHINGTON, DC 20001

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 08/26/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/889,598

Applicant(s)

COBBEN ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50 is/are allowed.
- 6) ☒ Claim(s) 26-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. <sup>43-45</sup> Claims 43 and 45 recites the limitation "the carrier" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim 44 depends from claim 43 and is similarly rejected.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 26, 30, 31, 36, 37, 41-43 and 46-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Cobben (WO 95/26274).

Cobben discloses a document (giro cheques, bankcheques, eurocheques, banknotes, shares, bonds, etc.) to be protected against forgery, the document comprising a security feature (4, 6 and 7) including a perforation pattern displaying gray tones (as seen on page 2, lines 1-3, Cobben discloses varying the width or depth of the perforations which would, inherently, display gray tones). Cobben discloses that each of the perforation holes are produced by a laser light (see page 3, lines 12-16 and page 4,

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lines 19-28). Cobben discloses, as seen above, that the depth of the perforations can be varied such that the perforation pattern extends over only a part of the thickness of the document.

Regarding claim 30, Cobben discloses the perforation representing an image (as seen in figure 2).

Regarding claim 31, see the above rejections.

Regarding claim 36, Cobben discloses the perforation pattern provided with perforations modulated in density and size as set forth in the above rejections.

Regarding claim 37, Cobben discloses the perforation pattern being provided locally with a perforation pattern differing from the rest of the perforation pattern (as seen in figure 2, "1" is a different pattern from "2").

Regarding claim 41, Cobben discloses the cross-section of the perforation pattern being unequal to a circle ("1" in figure 2 would be unequal to a circle in cross-section).

Regarding claim 42, Cobben discloses a code concealed in the representation of an image (see page 4, lines 36-38 through page 5, lines 1-3).

Regarding claim 43, Cobben discloses an intermediate layer with an ink (42) arranged in the carrier (as seen in figure3).

Regarding claims 46 and 47, Cobben discloses the image representing a personalized image applied by laser engraving as set forth above (see page 3, lines 37 and 38 through page 4, lines 1-3).

Regarding claims 48 and 49, Cobben inherently disclose the method for arranging a perforation pattern in a forge-proof document as set forth above.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27-29, 34, 35 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobben.

Regarding claims 27-29 and 40, Cobben discloses the claimed invention except for explicitly disclosing some of the perforations forming part of the perforation pattern extend at an angle differing from 90 degrees relative to the main plane of the document. It would have been obvious to one having ordinary skill in the art at the time the invention was made to position the perforation pattern at any desired angle, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claims 34 and 35, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. *In re Seid*, 73 USPQ 431.

Regarding claims 38 and 39, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Therefore, the reference applied is only required have the ability to perform the claimed function. Cobben has the ability to present a stereo image or an image which differs per angle of view.

7. Claims 32, 33, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobben in view of Belousov et al. ('342).

Cobben discloses the claimed invention except for the material being formed by ink which lights up under UV light and a vapor-deposited metal layer arranged in the perforations.

Belousov et al. disclose a tape data carrier for protecting articles and documents from counterfeiting and copying comprising a perforation pattern (as seen in figure 7) wherein at least some of the perforations forming part of the perforation pattern extend over only a part of the thickness of the document and the thickness of the remaining part of the document is modulated in accordance with the image to be displayed (see col. 9, lines 66-67 through col. 10, lines 1-5). When viewed against a bright background, the image would display gray tones. Belousov et al. further disclose the material being formed by ink which lights up under UV light (see col. 6, lines 29-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Cobben's invention to include vapor-deposited material in the perforations that is visible under UV light, as taught by Belousov et al., to increase the security features of the document.

***Allowable Subject Matter***

8. Claim 50 is allowed.

***Response to Arguments***

9. Applicant's arguments with respect to claims 26-49 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

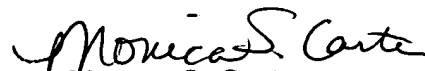
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose security documents.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Monica S. Carter  
Primary Examiner  
Art Unit 3722

August 20, 2003